

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Malcolm M. Smith
Serial No.: 10/033,572
Filing Date: November 2, 2001
Confirmation No.: 9167
Group Art Unit: 2614
Examiner: Alexander Jamal
Title: WIRELESS COMMUNICATION SYSTEMS WITH
 SIGNAL SELECTION AND COMBINATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Advisory Action mailed September 6, 2006, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

Claims 1-40 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kondo, et al. in view of Obuchi, et al. In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Advisory Action of September 6, 2006 and the Final Action of June 23, 2006, the Examiner indicates that the Obuchi, et al. patent discloses adding or averaging signal portions. However, the portions of the Obuchi, et al. patent cited by the Examiner are directed to an error rate measurement device that measures an error between bits received from base stations and generates a mean error rate between base stations. The error rates determined in the Obuchi, et al. patent are used in selecting a convolution encoded signal output from a plurality of convolution encoders. A composite device of the Obuchi, et al. patent may combine a plurality of convolution encoded signals according to a majority determination technique to produce an output. The majority determination technique is hardly the same as adding or averaging signal portions. In fact, the Obuchi, et al. patent discloses producing a lost bit if a majority determination cannot be made. (See col. 23, lines 4-9, of the

Obuchi, et al. patent). The merging of convolution encoded signals into one signal is performed in the Obuchi, et al. patent based on a selection process using majority determination and is not performed by adding or averaging signals as required by the claimed invention. Thus, the Obuchi, et al. patent fails to disclose adding or averaging of portions of first and second wireless signals received from first and second base transceiver stations in addition to selecting portions of the first and second wireless signals as provided in the claimed invention. Thus, the Examiner's proposed Kondo, et al. - Obuchi, et al. combination does not have a capability to add or average signal portions from different base stations let alone perform either of the steps of selecting between signal portions or combining signal portions as provided by the claimed invention.

Most notable of the legal errors present in the examination of the Application is a failure of the Final Action of June 23, 2006 to establish a prima facie case of obviousness of the claims in the Application rejected under 35 U.S.C. §103(a). There has been no mention of the three criteria for a prima facie case of obviousness as spelled out in M.P.E.P. §2143. The Examiner has not cited any language from the prior art that would suggest that the Kondo, et al. patent can be combined in any manner with the Obuchi, et al. patent. The Examiner only provides a baseless subjective and conclusory "it would have been obvious" statement for combining the Kondo, et al., and Obuchi, et al. patents without providing any objective reasoning or citing any evidence of record to support such a position. Moreover, the Examiner has not shown that the Kondo, et al. and Obuchi, et al. patents are analogous to the claimed invention or each other. The Examiner has not provided any reasons how the proposed combination of the Kondo, et al. and the Obuchi, et al. patent would have any expectation of success let alone a

reasonable expectation of success. Moreover, the Examiner has failed to show that the proposed combination would even work for its intended purpose according to the claimed invention.

As for teaching the claimed invention, the Kondo, et al. and Obuchi, et al. patents do not, either alone or in combination, teach or suggest selecting portions of a signal from different base stations let alone generating a signal portion using characteristics of the selected signal portions or combinations of the selected signal portions. The Examiner contends that the Kondo, et al. patent teaches selecting the best received frame on a frame-by-frame basis using the error rate and signal level. This contention is incorrect as the subject matter of the Kondo, et al. patent cited by the Examiner is merely directed to selecting one of two signals in their entirety based on either no error or highest reception level if both signals have errors. The only processing operation performed in the Kondo, et al. patent with respect to a signal portion (i.e., a frame) is error detection. Thus, the Kondo, et al. patent fails to disclose a capability to process signal portions from different base stations to generate a new signal portion. Similarly, the Obuchi, et al. patent processes entire signals and cannot select from signal portions of different base stations as required in the claimed invention. Thus, the structure that would result from combining the Kondo, et al. and Obuchi, et al. patents does not meet the terms of the claims.

CONCLUSION

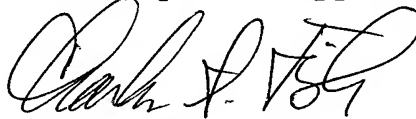
Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Charles S. Fish', is written over the printed name.

Charles S. Fish

Reg. No. 35,870

September 25, 2006

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